



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,239	07/02/2001	Thomas J. Kredo	7000-079	8230

27820 7590 10/06/2003

WITHROW & TERRANOVA, P.L.L.C.
P.O. BOX 1287
CARY, NC 27512

EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
----------	--------------

2645

8

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,239

Applicant(s)

KREDO ET AL.

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “audio server” claimed in claim 29 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make

Art Unit: 2645

and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “changing an appearance of the content” of claim 28 is not disclosed by the specification. Although, the section [0037] of specifications disclosed using capital letters, color blue and red, however, the claimed limitation “appearance” is much broader than what the specification supports. The “appearance”, in addition to what are supported by the specification, further includes other appearances like font sizes, underline, font types (times new roman, script, etc.), flashing fonts, shadow fonts, emboss fonts, engrave fonts, etc.

3. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “an audio server” of claim 29 is not disclosed by the specification. Throughout the specification, nowhere disclosed the limitation of “an audio server”. The Examiner noticed that “audio browser” was disclosed by the specifications. However, the “audio server” and “audio browser” are totally two different elements to one skilled in the art.

Also, the phrase “receiving at an IM proxy server the audible command” is not disclosed by the specification. The sections [0008] and [0009] both disclosed the audio command is converted to

Art Unit: 2645

a text form by the audio browser before the text-form command is sent to the IM proxy server.

And, the IM proxy server send the text-based message to the audio browser for converting to an audio command by the audio browser. The specification did not support “the audible command is received at the IM proxy server”.

Also, the phrase “passing the command back to the IM proxy server” is not disclosed by the specification. Nowhere in the specification supports the same command being passed back to the IM proxy server. Although, for example, see Fig. 1 of specification, User A may use a command “volume” in audio-form while User B may also use a command “volume” in text-form during the call dialog. However, UserA-volume and UserB-volume are two different commands. The specification did not support limitation of “passing the (same) command back”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4-11, 13, 16-23, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowens et al (US: 6389114), and in view of Dutta et al (US: 6453294).

Regarding claims 1, 13 and 25, Dowens et al teach on Abstract – provides a telecommunication relay device that relays communication from a first party to at least one second party (reads on claimed “creating a call dialog”).

Dowens et al teach on column 1 line 24-35, converting telephone user’s voice (claimed “audio command”) to text for chat room (claimed “instant messaging” and “sending the.....messaging service”). The audio command is received during the communication relays (claimed “call dialog”). Therefore, the command is received according to the call dialog.

Dowens et al failed to teach “the command including a message meaning with a message characteristic” and “creating an.....message characteristic”. However, Dutta et al teach on column 3 line 37-59, the “speech” and “word or phrase” of Dutta et al are the claimed “command”. The “boldface, italics or underline” and “capital characters” of Dutta et al are the claimed “characteristic”. The “transcribed text” of Dutta et al is the claimed “meaning”. The “speech to text transforms would transcode statements or command to text shorthand, subtext, or ‘emoticon’” of Dutta et al reads on the claimed “creating an.....message characteristic”.

It would have been obvious to one skilled at the time the invention was made to modify Dowens et al to have “the command including a message meaning with a message characteristic” and section (b) of claim 1 as taught by Dutta et al such that the modified system of Dowens et al would be able to support the message meaning, message characteristic, and creating an instant message to the system users.

Art Unit: 2645

Regarding claims 4, 5, 16 and 17, Dowens et al teach on column 3 line 50 smile emoticons. The smile emoticons are the claimed “emotional indicia” and reads on the claimed “characteristic relates to emotion”.

Regarding claims 6 and 18, Dowens et al teach on column 3 line 57 frown emoticon. The “frown” emoticon reads on the claimed “characteristic relates to personality”.

Regarding claims 7 and 19, Dowens et al teach on column 3 line 37-43 message characteristic relates to a relative volume.

Regarding claims 8 and 20, the rejections of claims 5-8 regarding message characteristics relate to volume, personality, and emotion as stated above apply.

Regarding claims 9 and 21, Dowens et al teach on column 3 line 37-43 regarding boldface, italics or underlined text for indicating characteristic. It is obvious that when plain text (default text font and size) is used it shows the claimed predefined characteristic.

Regarding claims 10, 11, 22 and 23, Dowens et al teach on column 3 line 60 to column 4 line 5 regarding text-to-audio (receiving an instant message, converting the instant message to an audio message, and sending the audio message to the telephony user).

Art Unit: 2645

Regarding claim 28, Dowens et al teach on column 3 line 37-59 audio-to-text transcoding (converting an audio command into an instant message). When the instant message is created the appearance of content is changed from audio form to text form.

5. Claims 2, 3, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowens et al and Dutta et al, and in view of Horvitz et al (US: 5864848).

Regarding claims 2 and 14, Dowens et al and Dutta et al failed to teach “providing a profile.....and the message characteristic”, However, Horvitz et al teach on Abstract, extracting data from one or more source objects (claimed “audio command”) and applying the data to one or more target objects (the claimed “instant message”) by using one or more templates (the claimed “profile”; column 4 line 26-46). The template includes source objects of user gesture (the claimed “characteristics”; column 4 line 7-13) and message meaning (column 12 line 8-13). It would have been obvious to one skilled at the time the invention was made to modify Dowens et al and Dutta et al to have “providing a profile.....and the message characteristic” as taught by Horvitz et al such that the modified system of Dowens et al and Dutta et al would be able to support the profile to the system users.

Regarding claims 3 and 15, the modified system of Dowens et al and Dutta et al as stated in claim 2 above failed to teach “the profile includes.....possible message characteristics”. However, Horvitz et al teach on column 11 line 2-5, the “relevant terms” of Horvitz et al is the claimed “unique text”. It would have been obvious to one skilled at the time the invention was made to modify Dowens et al and Dutta et al to have “the profile includes.....possible message

Art Unit: 2645

characteristics” as taught by Horvitz et al such that the modified system of Dowens et al and Dutta et al would be able to support the unique text to the system users.

6. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowens et al and Dutta et al, and in view of Hodges et al (US-PAT-NO: 6,449,365). Dowens et al and Dutta et al failed to teach sending an alert to the telephony user via at least one of the group consisting of calling, sending and email, sending a message via a short message service, and sending a page. However, Hodges et al teach on column 9 line 42 the notification server may transmit a notification message using a conventional short message service (SMS). Hodges et al also teach on column 9 line 46 the notification server may also transmit a notification message to the recipient’s conventional telephone. The “notification message” of Hodges et al is the claimed “alert”. The ‘conventional telephone’ of Hodges et al reads on the claimed “calling”. It would have been obvious to one skilled at the time the invention was made to modify Dowens et al and Dutta et al to have sending an alert to the telephony user via at least one of the group consisting of calling, sending and email, sending a message via a short message service, and sending a page as taught by Hodges et al such that the modified system of Dowens et al and Dutta et al would be able to support the alert to the system users.

Response to Arguments

Art Unit: 2645

7. Applicant's arguments filed on 6/17/03 have been fully considered but they are not persuasive.

- i) Applicant argues, on page 8, regarding "changing an appearance". As rejections stated above under 35 USC § 112, the claimed limitation is broader than what the specification supports.
- ii) Applicant argues, on page 8, regarding current amendments. The rejections have been stated above without changing referenced prior arts.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2645

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to TC2600's Customer Service FAX Number 703-872-9314.

Patent Examiner

Art Unit 2645

Ming Chow

(m)

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

